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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/510,089	06/20/2005	Munetake Ebihara	09812.0753-00000	4198
22852	7590	08/06/2008		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413				
EXAMINER				
MIZRAHI, DIANE D				
ART UNIT		PAPER NUMBER		
2165				
MAIL DATE		DELIVERY MODE		
08/06/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/510,089

Applicant(s)

EBIHARA ET AL.

Examiner

DIANE MIZRAHI

Art Unit

2165

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/02)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This action is responsive to the Request for Continued Examination filed June 18, 2008.

Claims 20-36 are pending in this Application.

Request for Continued Examination Under 37 CFR 1.114

This is in response to request for amendments filed June 18, 2008 Continued Examination Under 37 CFR 1.114.

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's Request for Continued Examination (RCE) submission and its accompanying amendment filed on June 18, 2008 has been entered.

Specification

The specification is objected to for failing to provide proper antecedent basis for the claimed subject matter of Claim 26-29 and 36. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o).

Claims 20-26 and 36 recites **"computer readable medium"**. There is no mention of a **"computer readable medium "** in the original specification.

Regarding Claims 26-36, the claims recite a **"process code"**. There is no mention of a **"process code "** in the original specification.

Appropriate correction is required.

Consideration of Claim Rejections under 35 USC § 101

Examiner considered claim rejections under 35 USC § 101 for Claims 20-25. Applicant's particular "information processing apparatus" is according to applicant "More specifically, the information processing apparatus includes a memory storing a usage condition interpretation program and a CPU as a processor." (Specification,

page 28, lines 6-10). Therefore, Examiner believes that no rejection under 35 USC § 101 is required for Claims 20-25.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 26-29 and 36 are rejected under 35 U.S.C. 101 because the claimed invention is directed non-statutory subject matter.

Claims 26-29 and 36 lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*.

There does not appear to be a specific and deliberate definition of the term "***computer readable medium***" in the disclosure as originally filed.

There does not appear to be intrinsic evidence of what applicant intends term computer readable medium and program to include in the disclosure as originally filed.

Accordingly, examiner is obliged to approach extrinsic evidence to determine what one of ordinary skill in the art at the time of the invention would reasonably consider term computer readable medium to include data structures, program modules or other data, carrier waves or other transport mechanisms.

In prior art reference Lee et al. (US Publication Number 20030126139, filed 12-28-2001), term computer readable medium appears to include embodiments "media typically embodies computer readable instructions, data structures, program modules or other data in a *modulated data signal such as a carrier wave or other transport mechanism* and includes any information delivery media" (see Lee et al., disclosure, page 19, lines 8-16).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 20-36 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The "process code" is critical or essential to the practice of the invention, but not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The amended claims 20-36 include the limitation, "process code", but Examiner is unclear as to what is Applicant's "process

code". There is no mention as to what is this "process code" in the original filed specification.

Examiner notes that according to 37 CFR 1.53 No new matter may be introduced into an application after its filing date. The newly added limitation, "a process code defining a comparison for the information processing apparatus to perform between the attribute information list and the property selection list" is considered new matter, because the claimed, "process code" is not described in the originally filed disclosure and thus considered as new matter. Examiner request Applicant to point out where in Applicant's specification "process code" is taught.

Correction is required.

Allowable Subject Matter

Claims 20-36 would be allowable if *rewritten or amended* to overcome the rejection(s) under 35 U.S.C. 112, First paragraph, and the rejection under 35 USC 101 set forth in this Office action.

The following is an examiner's statement of reasons for allowance:

The prior art of records does not teach the combination of claimed elements including: "before acquiring a content key for decrypting the content, determining whether the type and function included in the attribute information list matches the data contained in the property selection list, in which the property selection list, in particular, includes a process code defining a comparison for the information processing apparatus

to perform between the attribute information list and the property selection list when comparison includes when the type and function matches, granting access, and when the type and function do not match, the information processing apparatus denies the access to the content". Thus, prior art of record neither render obvious nor anticipates the combination of claimed elements in light of the specification.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Diane D. Mizrahi whose telephone number is 571-272-4079. The examiner can normally be reached on Monday-Thursday (9:30 - 4:30 p.m.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christian Chase can be reached on (571) 272-4190. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 305-3900 for After Final communication.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Art Unit: 2165

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

/Diane Mizrahi/

Diane.Mizrahi@USPTO.gov
Primary Patent Examiner
Technology Center 2100

July 26, 2008